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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,010	03/23/2004	Eric Franzoi	KOLC-P02-048	2809
28120	7590	09/27/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			MAYES, MELVIN C	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/807,010

Applicant(s)

FRANZOI ET AL.

Examiner

Melvin Curtis Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14,16-18 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14,16-18,24-26 and 28 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/23/04, 10/3/05</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Objections***

(1)

Claim 18 is objected to because of the following informalities: in line 1 "form" should be "from", in line 4, "m ferrous sulfate" should be "ferrous sulfate", in line calcium oxide sodium carbonate" should be calcium oxide, sodium carbonate" and in line 5, "slats" should be "salts." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

(2)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(3)

Claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16 and 17 recite the limitation "said treatment." There is insufficient antecedent basis for this limitation in the claim. There is no step of "treatment" recited in Claim 14.

***Claim Rejections - 35 USC § 103***

(4)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(5)

Claims 14, 16-18, 24, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scher et al. 4,430,375 in view of Birchall et al. 3,839,078.

Scher et al. disclose a method of making an abrasion-resistant laminate comprising: providing a printed pattern paper; coating the paper with a mixture of hard mineral particles such as alumina and binder; impregnating the paper with a melamine resin (thermosettable resin); and laminating the paper to a core sheet (substrate) (col. 6-8). Scher et al. do not disclose adhering the printed pattern to the paper by a mordant.

Birchall et al. teach that cellulosic substrates such as paper are impregnated with aluminum phosphate for various reasons such as to improve the printability thereof. Birchall et al. teach that aluminum phosphate solution can be applied to the substrate by either spraying or by impregnation (col. 17, line 60 – col. 18, line 46).

It would have been obvious to one of ordinary skill in the art to have modified the method of Scher et al. for making an abrasion-resistant laminate having printed paper by also coating or impregnating the paper with aluminum phosphate, as taught by Birchall et al., to improve the printability thereof. By providing the paper as impregnated with aluminum phosphate, the printed pattern is obviously adhered to the paper by a mordant of aluminum phosphate, as claimed. Coating the paper with aluminum phosphate solution either before printing the paper (and thus before the impregnating step as claimed in Claim 17) or impregnating the paper by including the aluminum phosphate in the melamine resin for impregnation of the paper would have been obvious to one of ordinary skill in the art, as Birchall

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et al. teach that aluminum phosphate solution can be applied to the substrate by either spraying or by impregnation.

(6)

Claims 14, 16-18, 24, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 592 013 in view of Birchall et al. 3,839,078.

EP '013 disclose a method of making an decorative laminate comprising: providing a printed pattern cellulose paper; impregnating the paper with a thermosetting resin; coating the impregnated paper with small hard particles such as alumina; and laminating the paper to a base layer (substrate) (entire document). Scher et al. do not disclose adhering the printed pattern to the cellulose paper by a mordant.

Birchall et al. teach that cellulosic substrates such as paper are impregnated with aluminum phosphate for various reasons such as to improve the printability thereof. Birchall et al. teach that aluminum phosphate solution can be applied to the substrate by either spraying or by impregnation (col. 17, line 60 – col. 18, line 46).

It would have been obvious to one of ordinary skill in the art to have modified the method of EP '013 for making a decorative laminate having printed cellulose paper by also coating or impregnating the paper with aluminum phosphate, as taught by Birchall et al., to improve the printability thereof. By providing the paper as impregnated with aluminum phosphate, the printed pattern is obviously adhered to the paper by a mordant of aluminum phosphate, as claimed. Coating the paper with aluminum phosphate solution either before printing the paper (and thus before the impregnating step as claimed in Claim 17) or impregnating the paper by including the aluminum phosphate in the thermosetting resin for

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impregnation of the paper would have been obvious to one of ordinary skill in the art, as Birchall et al. teach that aluminum phosphate solution can be applied to the substrate by either spraying or by impregnation.

(7)

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 592 013 in view of Birchall et al. 3,839,078 as applied to claim 25, and further in view of Hansson et al. 6,685,993.

EP '013 discloses coating the impregnated printed paper with small hard particles such as alumina to provide abrasion resistance.

Hansson et al. teach that a decorative laminate is provided with a protecting, wear resistant translucent surface by applying a number of layer of curable lacquer by the steps of applying, to a lacquer base layer, hard particles such as alumina of average particle size in the range of 10-150 microns, applying a covering layer of lacquer and applying, to the cover lacquer layer, hard particles of average particle size in the range of 50 nm – 30 microns.

It would have been obvious to one of ordinary skill in the art to have modified the method of the references as combined by providing the coating of alumina particles for abrasion resistance by applying layers of lacquer and alumina particles of average particle size in the range of 10-150 microns and alumina particles of average particle size in the range of 50nm – 30 microns on the lacquer layers, as taught by Hansson et al., as known to provide a decorative laminate with a protecting, wear resistant translucent surface. Providing larger mineral particles and smaller particles of mean particle diameter of one-half that of the larger particles, as claimed, is encompassed by the ranges as taught by Hansson et al. of providing alumina particles of

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average particle size in the range of 10-150 microns and alumina particles of average particle size in the range of 50nm – 30 microns.

### ***Double Patenting***

(8)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(9)

Claim 28 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,026,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

U.S. Patent No. 7,026,038 claims a decorative laminate including décor sheet bonded to a substrate, the décor sheet having a print on a surface thereof and being impregnated with a thermosettable resin and a mordant, the mordant adhering the print to the surface. The decorative



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laminate made by the method of Claim 1, as claimed in Claim 28, is a decorative laminate encompassed by the decorative laminate as claimed by Claim 1 of U.S. Patent No. 7,026,038.

***Allowable Subject Matter***

(10)

Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

(11)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references disclose methods of making decorative laminates.


(12)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Melvin Curtis Mayes  
Primary Examiner  
Art Unit 1734

MCM  
September 20, 2006